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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,512	10/24/2003	Tor McPartland	57974-5006	9303

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EXAMINER	
PRYOR, ALTON NATHANIEL	
ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/692,512	MCPARTLAND, TOR	
	Examiner	Art Unit	
	Alton N. Pryor	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *24 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-7 and 9-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-7,9-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 12/4/03
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,5,6,9-11,13-15,17,22 are rejected under 35 U.S.C. 102(b) as being anticipated by Dotolo (US 4379168; 4/5/83). Dotolo teaches a composition comprising 20 % d-limonene, 4 % emulsifier, and remainder water (76 %). See Example 14. Dotolo teaches that the d-limonene contains a preservative. See column 6 lines 40-43. Dotolo teaches that the composition can repel or kill insects. See column 7 lines 34-43. Dotolo teaches that the composition controls lice. See column 7 lines 3-4. Dotolo teaches a method of applying the composition to house surfaces such as walls and floors. See column 7 lines 5-11. Doloto teaches that the composition can be made by the simple act of mixing d-limonene, emulsifier, and remainder water. See claims 34 – 36.

Claims 1,6,13,20 are rejected under 35 U.S.C. 102(b) as being anticipated by Liebman (CA 2060594; 8/6/92). Liebman teaches a method of applying a shampoo or lotion composition comprising d-limonene, emulsifiers (cocoamido propyl betaine, sodium lauryl sulphate, ethyl methacrylate) and water and / or alcohol to human head / hair / skin to contact lice. Leibman teaches that the method is used to prevent lice

infestation in human hair and on skin. See page 1 lines 5-8, page 3 lines 5-22, page 6 examples.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotolo as applied to claims 1-3,5,6,9-11,13-15,17,22 above in 102(b) rejection. Dotolo teaches all that is recited in claims 4,16 except for amount (0.01-5%) of preservative. It would have been obvious to one having ordinary skill in the art to determine the optimum amount of preservative to include in the composition. One would have been motivated to do this in order prevent the composition from becoming rancid.

Claims 2,3,7,9,11,12,14,15,21,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liebman as applied to claims 1,6,13,20 in further view of Synder (US 6063771; 5/16/00). Liebman teaches all that is recited in claims 2,3,7,9,11,12,14,15,21, 24 except for the invention comprising 1) a polyethoxylated castor oil and 2) instant amounts / ranges of ingredients: d-limonene, emulsifying agent, and hydrophilic solvent. However, Synder teaches a method of applying a lotion composition comprising PEG-castor oil to human skin to control lice. See examples 1-3. It would have been obvious to one having ordinary skill in the art to modify the invention taught by Liebman to include PEG-castor oil taught by Synder. One would have been motivated to do this in

order to enhance the consistency of the lotion and because both inventions independently are to the control of lice on human skin. With respect to the amount / ranges of ingredients, one having ordinary skill in the art would have been expected to determine the optimum amounts / ranges of ingredients. One would have been motivated to do this in order to develop a lotion that would have been effective in killing lice, but yet non-toxic to humans.

Claims 1,2,6,7,9,11-15,17-19,21,24,25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins, Jr. (US 5951991; 9/14/99). Wilkins, Jr. teaches a method of applying a composition comprising 2-10 % d-limonene, 1-10 % emulsifier, and 80-96 % water to crop or plants to control fire ant infestation. See abstract, column 2 line 1- column 3 line 35. Wilkins, Jr. does not teach 1) the invention comprising instant amounts / ranges of ingredients: d-limonene, emulsifying agent, and hydrophilic solvent, 2) the plants being rose buches and ornamentals. Wilkins, Jr. teaches 2-10% d-limonene; whereas, the instant claims uses a high of 1.5% d-limonene. In the absence of unexpected results, one having ordinary skill in the ad would expect Wilkins' composition comprising 2% d-limonene to yield similar if not the same results as the instant composition comprising 1 .5% d-limonene which is just slightly below 2%. With respect to the amount / ranges of ingredients, one having ordinary skill in the art would have been expected to determine the optimum amounts / ranges of ingredients. One would have been motivated to do this in order to develop a composition that would have been effective in killing insects, but yet non-toxic to humans. With respect to rose bushes and ornamentals, said plants are species within the plant genus; the instant

method to said named plants. One would have been motivated to do this since rose bushes and ornamentals are species within the plant genus.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 25 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 30 of copending Application No. 10692512. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. Both applications are to a method of controlling fire ants using a composition containing about 0.7 to about 1.5 % limonene, about 1 % to about 25 % by wt of an emulsifying agent, and 98 % to about 55 % by of a hydrophilic solvent. Note that application 10/235450 employs the language "consisting essentially of", whereas, the instant claims employ "comprising" language. However, instant invention does not include ingredients that would materially impact it. For this reason, the claims of both inventions are of the same scope.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 25 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6784211. Although the conflicting claims are not identical, they are not patentably distinct from each other because both US '211 and instant application are to a method of controlling fire ants using a composition containing about 0.7 to about 1.5 % limonene, abut 1 % to about 25 % by wt of an emulsifying agent, and 98 % to about 55 % by of a hydrophilic solvent. Instant claim does not disclose the limitation "about 0.01 % to about 5 % by wt of a food-grade preservative as in claim 1 of US '211. However, instant application discloses that 0.01 % to about 1 % food-grade preservative can be added to the invention. See instant application page 6 third full paragraph. It would have been obvious to one having ordinary skill in the art to add the preservative to instant invention. One would have been motivated to do this in order to prevent the composition from becoming rancid.

Claims 1-6 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 31-34,41-48 of copending

Application No. 10/235,450. Although the conflicting claims are not identical, they are not patentably distinct from each other because both inventions disclose a composition containing d-limonene, hydrophilic solvent, and emulsifying agent and possibly a preservative. Both inventions are to the controlling (repelling or killing) insects with the composition. It would have been obvious to one having ordinary skill in the art to add the preservative to instant invention. One would have been motivated to do this in order to prevent the composition from becoming rancid. With respect to the amount / ranges of ingredients, one having ordinary skill in the art would have been expected to determine the optimum amounts / ranges of ingredients. One would have been motivated to do this in order to develop a composition that would have been effective in killing or repelling insects including fire ants, but yet non-toxic to humans. Although 10/235450 discloses method claims, whereas, instant claims disclose composition claims, the method claims of 10235450 make the instant invention obvious (since the method claims disclose the compositions of the instant invention).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 703 308-4691. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703 308-4628. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alton Pryor
Primary Examiner
AU 1616